

REMARKS

Claims 1-87 remain pending in this application, of which 1-2, 12-13, 24, 31, 33, 41-42, 56, 63-65, 79 and 86-87 are independent. Claims 2, 24 and 56 have been amended in response to a rejection under 35 U.S.C. § 112, ¶ 2.

Request for Status on Petition To Correct Inventorship

Applicants filed a Petition To Correct Inventorship Under 37 C.F.R. § 1.48(a) on July 20, 2004 to add co-inventor Ludwig B. Chincari. A declaration and power of attorney executed by both inventors was filed with this petition.

Applicants have not yet received a decision on this petition, and therefore request its status.

Claims 2, 24 and 56 Are Not Indefinite

The Office rejected claims 2, 24 and 56 under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended these claims in accordance with the Office's remarks to clarify the recitation of the claimed invention. The amendments do not narrow the claim scope and no surrender of subject matter is intended.

Reconsideration and withdrawal of the rejection of claims 2, 24 and 56 is therefore respectfully requested.

Claims 1-8, 12-19, 24-27, 31-37, 41-59, 63-82, 86 and 87 Are Patentable Over Breen

The Office rejected claims 1-8, 12-19, 24-27, 31-37, 41-59, 63-82, 86 and 87 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,615,188 to Breen et al. [hereinafter "Breen"]. Essentially, the Office contends that Breen discloses all of the elements of the claims at issue. Applicants respectfully disagree with the Office's characterization of this reference vis-à-vis the claims at issue.

Inter alia, Breen fails to anticipate the above independent claims because Breen relates to a method for aggregating order flow – but not for creating contingent orders from a plurality of

orders for a given instrument. For example, claim 1 recites “combining a value-based order” and a “share-based order” to form a “plurality of contingent orders” and then executing a trade in accordance with one of the plurality of contingent orders. The other independent claims (2, 12-13, 24, 31, 33, 41-42, 56, 63-65, 79 and 86-87) include recitations of functionality related to processing of value-based orders and share-based orders to form a plurality of contingent orders, which are also not disclosed by this reference. Breen simply fails to disclose anything related to contingent orders, as set forth in claim 1. More specifically, the citation provided by the Office for this teaching (Breen, Col. 9, lines 18-32) fails to disclose anything regarding a plurality of *contingent* orders.

As the entire claimed invention is not included in Breen, a *prima facie* case for anticipation cannot be made because this reference does not disclose all elements of Applicants' rejected claims; hence claims 1-8, 12-19, 24-27, 31-37, 41-59, 63-82, 86 and 87 are patentable over Breen. Reconsideration and withdrawal of the rejection of claims 1-8, 12-19, 24-27, 31-37, 41-59, 63-82, 86 and 87 is therefore respectfully requested.

Claims 9-11, 20-23, 28-30, 38-40, 60-62 AND 83-85 Are Patentable Over Breen

The Office rejected claims 9-11, 20-23, 28-30, 38-40, 60-62 and 83-85 under 35 U.S.C. §103(a) as being unpatentable over Breen. Essentially, the Office contends that Breen discloses all of the elements of the claims at issue, except for disclosing the varying price in an equation format, for which the Office takes Official Notice, and contends it would be obvious to add such teaching to Breen.

At a minimum, claims 9-11, 20-23, 28-30, 38-40, 60-62 and 83-85 are patentable over Breen for the same reasons as the independent claims from which these claims ultimately depend, as set forth above.

Additionally, pursuant to M.P.E.P. 2144.03(C) Applicants respectfully traverse the taking of Official Notice and request that the Office provide documentary evidence of the claimed equations in support thereof, for Applicants contend that the claimed equations are not old in the art. The equations are used to determine a schedule of contingent orders - not merely for calculating a price for a number of shares.

Therefore, claims 9-11, 20-23, 28-30, 38-40, 60-62 and 83-85 are not rendered obvious by Breen. Reconsideration and withdrawal of the rejection of claims 9-11, 20-23, 28-30, 38-40, 60-62 and 83-85 is therefore respectfully requested.

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.


The Office is authorized to charge the one-month small entity extension of time fee of \$60.00 to Deposit Account No. 11-0600. A copy of this page is provided for this purpose.

Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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